

1. The amendment of 11/16/07 has been entered. Claims 5 and 7-9 are pending.
2. Newly submitted claims 5 and 7-9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions would have been required under 35 U.S.C. 121:

- I. Claims 1-2 and 4-6, as were previously examined, drawn to coating compositions and methods for forming a silica-containing film onto a base material and then drying the coated layer, classified in class 524, subclass 261 among others depending on the particulars of the composition and class 427, subclass 385.
- II. Claims 5 and 7-9, as newly presented, drawn to a method for forming an interlayer insulating film of a semiconductor element, classified in class 228, subclass 123.1.

The inventions are independent or distinct, each from the other because:

Inventions of the processes as originally claimed and examined and of the methods that have been newly presented are directed to related as distinct processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed (1) the inventions as claimed are either not capable of use together because the coating of the originally presented methods did not require more than the two recited layers and the newly recited "interlayer" limitation and semiconductor and insulating film limitations require limitations not required of

the previously presented methods or can have a materially different design, mode of operation, function such as the originally presented methods do not need to have the instantly claimed design, mode of operation or function since the originally presented method claims need not give an insulating film in a semiconductor nor be an interlayer, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions of the originally presented compositions and the newly claimed methods are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product of the originally presented claims can be used in a materially different process such as making a film which is not an interlayer as shown by the originally presented method claims verses the newly presented method claims.

Restriction for examination purposes as indicated would have been proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5 and 7-9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The amendment filed on 11/16/07 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). In other words, none of the remaining claims are to the originally presented invention. The only claims presented are directed to a distinct invention from that originally presented. Amending the originally presented claims to a distinct invention is the equivalent of canceling all claims drawn to the elected invention since no claims remain that are drawn to the originally presented invention. The remaining claims are not readable on the elected invention because of the reasons stated in paragraph 2 above.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is

longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796